06/22/01

Paper No. 9
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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Texas Instruments Incorporated

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Serial No. 75/634,910

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Gary C. Honeycutt of Navarro IP Law Group, P.C. for Texas Instruments Incorporated.

Kathleen M. Vanston, Trademark Examining Attorney, Law Office 103 (Michael Hamilton, Managing Attorney).

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Before Hohein, Chapman and Holtzman, Administrative Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

Texas Instruments Incorporated has filed an application to register on the Principal Register the mark shown below

ActiveDSP

for the following goods, as amended: “computer software for the operation of a data link between a general purpose

processor and digital signal processing circuits" in International Class 9.[1]

Citing Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), the Examining Attorney has finally refused registration on the ground that applicant's mark, when used on its goods, is merely descriptive thereof.

Applicant has appealed, and both applicant and the Examining Attorney have filed briefs. Applicant did not request an oral hearing.

As evidence in support of the refusal to register, the Examining Attorney relies upon the following definition of the letters "DSP" from The Computer Glossary: The Complete Illustrated Dictionary (7th ed.):

> 1. (Digital Signal Processor) A special-purpose CPU used for digital signal processing (see below). It provides extra fast instruction sequences, such as shift and add and multiply and add, commonly used in math-intensive signal processing applications. 2. (Digital Signal Processing) A category of techniques that analyze signals from sources such as sound, weather satellites and earthquake monitors. Signals are converted into digital data and analyzed using various algorithms such as Fast Fourier Transform. In sound cards, DSP chips are used to compress and decompress audio formats as well as

[1] Application Serial No. 75/634,910, filed February 2, 1999, based on applicant's assertion of a bona fide intention to use the mark in commerce.

> to assist with recording and playback and speech synthesis. Other audio DSP uses are the DSP chips in stereo amplifiers, which are programmed to simulate concert hall and cinema effects for home theater and music listening.

The Examining Attorney also relies upon a few excerpted stories from the Nexis database, some showing use of the term "active DSP" referring to digital signal processors/systems, examples of which follow (emphasis added):

> Headline: Design a multi-DSP system with just one bus
> ...and the LSB address lines from the bus that are driven by the **active DSP**. The **active DSP** can see only a limited portion of the input buffer.
> ...Using a bus arbiter, the system's data throughout will be a combined play between the **active DSP** on the bus (granted by the arbiter) and the Next_Block_Counter logic.
> ...the finishing moment is created by the reading of the INP 0 by the DSP that's active on the bus. The **active DSP** reads this bit (memory mapped), and then stops and releases its bus request...., "Electronics Design," March 6, 1995;
>
> Headline: Rockwell Intros HDSL Set
> ...The new chip set, called the Bt8970, is a full-duplex 2B1Q transceiver that encompasses all the **active DSP** analog front-end circuits for an HDSL transceiver in a single device...., "Electronic Buyers' News," March 31, 1997; and

> Headline: Audio's functionality is Sahara's bounty
> ...The modular processor cores can be regrouped to build other constellations. A special version called Sahara Lite, tailored for intelligent **active DSP** speaker applications, is planned for 1998. It will combine stereo DSP with D/A conversion and will have only one DSP and the network interface...,
> "Electronic Engineering Times,"
> September 15, 1997.

Finally, the Examining Attorney relies on a printout of a few pages from applicant's website regarding its "TMS320 DSP MediaCard" in which applicant refers to certain features designed into the card, such as, "Direct PC control of active DSP tasks and memory pages," "On-board logic to arbitrate-memory bus between DSP and PC with software programmable features," "Bootload of code to the DSP from its global-data memory under PC control," "Smart mode operation for the PC to control DSP directly and share common memory with DSP," and "Separate attribute memory to the PC per PCMCIA spec (spec omitted), also available to the DSP in its global data memory."

Applicant does not dispute that "DSP" refers to Digital Signal Processors, and that "active is a characteristic of some class of DSP." (Brief, p. 3.) In fact, applicant offered to disclaim the letters DSP. (Brief, p. 11.) However, applicant contends that its mark

"ActiveDSP" as a composite mark is arbitrary or suggestive; and that its goods are not DSP circuits, but rather are computer software, and in the context of computer software the term "active" does not have a known meaning and is not merely descriptive. Specifically, applicant contends as follows:

> Not all DSP circuits are active. An active DSP is one that is able to change environments. Applicant is applying 'Active' to computer software. In a software context, 'active' does not have a known meaning. Even if Active DSP was descriptive of some DSP circuits, the mark still would not be 100 percent descriptive of the goods, and hence, not merely descriptive. (Brief, p. 8.)

The test for determining whether a mark is merely descriptive under Section 2(e)(1) of the Trademark Act is whether the term immediately conveys information concerning a quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used. See In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215 (CCPA 1978); In re Venture Associates, 226 USPQ 285 (TTAB 1985); and In re Bright-Crest, Ltd., 204 USPQ 591 (TTAB 1979). The determination of mere descriptiveness must be made in relation to the goods or services for which registration is sought, the context in which the term or phrase is being or will be

used on or in connection with those goods or services, and the impact that it is likely to make on the average purchaser of such goods or services. See In re Consolidated Cigar Co., 35 USPQ2d 1290 (TTAB 1995); and In re Pennzoil Products Co., 20 USPQ2d 1753 (TTAB 1991). That is, the question is not whether someone presented with only the mark could guess what the goods or services are. Rather, the question is whether someone who knows what the goods or services are will understand the mark to convey information about them. See In re Home Builders Association of Greenville, 18 USPQ2d 1313 (TTAB 1990); and In re American Greetings Corp., 226 USPQ 365 (TTAB 1985).

We agree with the Examining Attorney that the applied-for mark "ActiveDSP" (in the special form shown above) immediately and directly conveys information about a significant feature or function of applicant's goods ("computer software for the operation of a data link between a general purpose processor and digital signal processing circuits"). A significant function of applicant's computer software, as identified, is to provide a data link between a general purpose processor and DSP circuits. Clearly, applicant's computer software (as identified) is associated with DSP circuits. Moreover, on applicant's webpage, in referring to its DSP MediaCard,

applicant states that said product has an "on board DSP"; that "DSP algorithms can be loaded by the host PC"; and "once the program is loaded, the host may command the DSP to execute the algorithms as a co-processor." Applicant specifically lists as one feature of the DSP MediaCard as "Direct PC control of active DSP tasks and memory pages."[2] Computer software is loaded or embedded onto the chip. At this intersection of the high technology world, applicant is attempting to create a distinction between the hardware and the software which, in this situation, is a distinction without any real difference, particularly to the ultimate consumer. The purchasing public would clearly understand that applicant's software, if and when used on or in connection with the identified goods, is intended to be used in conjunction with active DSPs. See In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); In re Omaha National Corporation, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); In re Intelligent Instrumentation Inc., 40 USPQ2d 1792 (TTAB 1996); and In re Time Solutions, Inc., 33 USPQ2d 1156 (TTAB 1994).

[2] Applicant did not address the information presented by the Examining Attorney from applicant's webpage.

Suffice it to say that, based on the record before us, applicant's arguments to the contrary do not persuade us of a different result herein.

Finally, even if applicant became the first (and/or only) entity to use the term "ActiveDSP" in relation to computer software for the operation of a data link between a general purpose processor and digital signal processing circuits, such is not dispositive where, as here, the term unquestionably projects a merely descriptive connotation. See In re Tekdyne Inc., 33 USPQ2d 1949, 1953 (TTAB 1994), and cases cited therein. We believe competitors would have a competitive need to use this term. See 2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §11:18 (4th ed. 2000).

Decision: The refusal to register under Section 2(e)(1) is affirmed.